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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,347	06/12/2001	Mats Nystrom		2187

7590 01/19/2005

Law Offices of David J. Serbin
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EXAMINER	
LANGEL, WAYNE A	
ART UNIT	PAPER NUMBER
1754	

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/878,347	NYSTROM ET AL.	
	Examiner	Art Unit	
	Wayne Langel	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 7-11 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schreyer et al. or Giesselmann et al. or Goor et al., for the reasons given in the last Office action. Applicant's argument, that Giesselmann et al. is silent as to the composition of the quinone solvent, is not convincing. The liquid triazine employed in the process of Giesselmann et al. could be considered to be either the quinone solvent or the hydroquinone solvent. If it is considered to be the hydroquinone solvent, then Giesselmann et al. anticipates these claims since Giesselmann et al. clearly disclose at column 2, line 1 that 1,2,3,4-tetramethylbenzene can be employed as a sole quinone solvent, i.e., the quinone solvent would constitute 100% by weight of the durene. If the triazine of Giesselmann et al. were considered to constitute the quinone solvent, the triazine could be present in an amount as low as 15% by volume, and the durene could then be present in an amount as high as 85% by volume. Applicant's argument, that Schreyer et al. provide the guidance to preferentially select isodurene over the myriad choices of alkyl substituted aromatics encompassed at column 3, lines 1-11, is not convincing. Schreyer et al. clearly teach at column 2, lines 18-23 that isodurene can be employed as a solvent, which is all that is necessary for anticipation. It is not necessary that Schreyer et al. recognize any particular advantages of using isodurene over the other solvents disclosed. Applicant's argument, that Goor et al. disclose a process wherein the working solution may consist of a single solvent, i.e., tetrasubstituted

ureas, is not convincing. The tetrasubstituted ureas disclosed by Goor et al. could be considered to be either the quinone solvent or the hydroquinone solvent. If it is considered to be the hydroquinone solvent, then Goor et al. would anticipate these claims, since Goor et al. clearly teach at column 4, line 51 that isodurene may be employed as the sole quinone solvent. If the tetrasubstituted ureas are considered to be the quinone solvent, then Goor et al. would contemplate the use of the isodurene in an amount of at least 15 weight percent of the quinone solvent, since Goor et al. teach at column 10, lines 27-31 that the volume ratio of substituted urea to aromatic hydrocarbon is from 10 to 50 parts of substituted urea to 90 to 50 parts of aromatic hydrocarbon. Applicant's argument, that the present invention is based on the finding that when using isodurene in an amount of 15 to 100% of the quinone solvent, the quinone solvent would have an improved quinone dissolving capacity, is not convincing, since the references clearly disclose use of the isodurene in an amount of 15 to 100% o the quinone solvent, as discussed hereinbefore. Applicant's argument, that this effect has not been realized or recognized by any of Giesselmann et al., Schreyer et al. or Goor et al., either alone or in combination, is not convincing, since it is only necessary that the references clearly disclose or suggest doing what applicant has done. It is not necessary that the references appreciate all the advantages of doing what applicant has done.

Claims 4-6 and 12-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goor et al. or Giesselmann et al. or Schreyer et al., for the reasons given in the last Office action. Applicant's arguments are not convincing, for the reasons given hereinbefore.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne A. Langel whose telephone number is (571) 272-1353. The examiner can normally be reached on Monday through Friday from 8 A.M. to 3:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (571) 272-1358. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WAL:cdc
January 13, 2005

Wayne A. Langel

WAYNE A. LANGEL
PRIMARY EXAMINER